

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

### **REMARKS/ARGUMENTS**

The Examiner is thanked for the clarity and conciseness of the previous Office Action, and for the citation of references, which have been studied with interest and care.

This Amendment is in response to the Office Action mailed August 25, 2005. In the Office Action, claims 1, 3-14, 16-19, 21-32, 34-37, 39-50 and 52-54 stand rejected under 35 U.S.C. § 103(a).

Applicant has amended independent claims 1, 19, and 37 to further clarify the embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

### ***Rejection Under 35 U.S.C. § 103***

Claims 1, 3-14, 16-19, 21-32, 34-37, 39-50 and 52-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,426,455 issued to Hasegawa (hereinafter Hasegawa) in view of U.S. Patent No. 6,664,460 issued to Pennock et al. (hereinafter Pennock).

As stated in MPEP §2141.03:

A prima facie obviousness rejection requires the three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references of themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP §2141.03. (Emphasis added).

MPEP §2141.03 further warns that *impermissible hindsight must be avoided*.

Furthermore, with regards to obviousness, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. *However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. (Emphasis added).

Applicant respectfully submits that amended independent claims 1, 19, and 37 are not rendered obvious by Hasegawa in view of Pennock, because Hasegawa and Pennock, neither alone nor in combination, teach or suggest the claim limitations of amended independent claims 1, 19, and 37.

Hasegawa is related to a very different invention.

As set forth in the Abstract of Hasegawa, Hasegawa states states that:

"The fee for practicing to play a musical instrument is charged on a user so that the user may practice to play the musical instrument with eagerness when the user practices to play the musical instrument using a terminal device that can be connected to a server...A terminal device 10 can be connected to a server via a network NW. A keyboard instrument 26 is connected to the terminal device 10, and the user practices to play the musical instrument with the use of the keyboard instrument 26...Practice information representing the state of the users practicing to play the musical instrument is transmitted to server 30 to be stored within server 30. Server 30 determines the fee for the users playing practice and the fee for materials used for practicing to play by discounting the fees in accordance with the practice information, and charges the determined fees on the user..." (Abstract, emphasis added).

Thus, Hasegawa is related to the transmission of "practice information" related to a user's practicing for the determination of fees and to encourage a user to practice.

In contrast thereto, and as set forth in Applicant's amended independent claims 1, 19, and 37, Applicant's claim limitations relate to: in response to a user selecting a musical piece, transmitting *a session file associated with the musical piece, the session file including an audio file and multimedia data...* processing the session file utilizing a computing device *to present a multimedia presentation of the audio file to the user...* coupling the musical instrument to the

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

computing device such that *an audio signal from the musical instrument generated responsive to a user playing the musical instrument is transmitted to the computing device...displaying a control panel graphical interface including an amplifier for a musical instrument, the control panel graphical interface having settings that define sound characteristics for the musical instrument to alter the audio signal ...and...creating a mixed signal that combines the altered audio signal with the audio file, the mixed signal being transmitted through a sound device such that the user can play the musical instrument in conjunction with the multimedia presentation of the audio file.*

Thus, the embodiments of Applicant's invention are very different than that disclosed in the Hasegawa reference. In particular, contrary to the Office Action's assertion, Applicant can find no teaching or suggestion of transmitting a session file associated with a musical piece, in which the *session file includes an audio file and multimedia data*. The Examiner cites the Abstract, Figure 1, and column 5, lines 56-column 6, line 2, for this teaching. However, Applicant cannot particularly find this teaching or suggestion. Applicant respectfully requests that the Examiner particularly cite the text for this teaching.

Looking particularly at column 5, line 56-column 6, line 2, this section of the Hasegawa patent states:

"Next, the user purchases a product needed for the playing practice. In this case, purchase controlling section 103 informs server 30 of the teaching material (product) that the user wishes to purchase, in accordance with the user's instruction using keyboard 18 and mouse 19. In server 30, sale controlling section 203 presents the teaching materials stored in the teaching material (product) storing section 213 together with the fees for the teaching materials to terminal device 10. The presented teaching materials and fees are displayed on display 22. Here, the teaching materials herein referred to are, for example, subprograms started on the playing-practice program to be used for the playing practice, MIDI data of the music for practice that is used for the playing practice, music score data for printing, and others." (Emphasis Added).

Thus, Hasegawa teaches that a user purchases a teaching material product and that teaching materials refer to subprograms started on the playing-practice program to be used for

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

playing practice, MIDI data of the music for practice that is used for playing practice, music score data for printing, and others.

Applicant respectfully submits that there is no specific teaching or suggestion of a session file associated with a musical piece *that includes an audio file and multimedia data and that the session file is processed by the computing device to present a multimedia presentation of the audio file to the user.*

Moreover, nowhere does Hasegawa teach or suggest: *displaying a control panel graphical interface including an amplifier for a musical instrument, the control panel graphical interface having settings that define sound characteristics for the musical instrument to alter the audio signal ...and...creating a mixed signal that combines the altered audio signal with the audio file, the mixed signal being transmitted through a sound device such that the user can play the musical instrument in conjunction with the multimedia presentation of the audio file.*

In contrast, as described is Hasegawa in Column 7, line 27 through line 63, Hasegawa's methodology is quite different:

Next, an explanation will be given on the case in which the user practices to play a musical instrument using the aforesaid purchased teaching material. Practice controlling section 105 displays the tasks for practice on display 22, and allows the user to practice playing a keyboard instrument 26. As described above, the playing practice is successively carried out for each course on the basis of the purchased teaching material stored in teaching material storing section 113, and partial practices are carried out in each course...For this presentation, practice controlling section 105 may display a portion of the music score as a task for the practice of this time on display 22, or may display a key-pressing indication mark corresponding to the music score on a figure of the keyboard instrument. Further, practice controlling section 105 successively supplies the data representing the tone pitches in the MIDI data related to the task for practice to sound source circuit 25, in accordance with the passage of time defined by the data representing the tone lengths in the MIDI data, whereby sound source circuit 25 reproduces sound signals corresponding to the data representing the tone pitches...The user carries out the playing practice using keyboard instrument 26 upon seeing the instruction on display 22 and/or listening the sound reproduced by sound source circuit 25. The information on playing that accompanies the playing practice is supplied to sound source circuit 25, whereby sound source circuit 25

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

forms music sound signals on the basis of the information on playing. The music sound signals are input into sound system 27 which in turn generates music sounds corresponding to the sound signals....(Emphasis Added).

As set forth in the description of the playing practice of Hasegawa, Hasegawa supplies MIDI data for playing practice with keyboard instrument to reproduce desired music tones for the particular piece of music being practiced. There is no teaching or suggestion of creating a mixed signal that combines an altered audio signal (e.g. based upon graphical interface settings) with an audio file, the mixed signal being transmitted through a sound device such that the user can play the musical instrument in conjunction with a multimedia presentation of an audio file.

Further, there is not teaching or suggestion of displaying a control panel graphical interface including an amplifier for a musical instrument, the control panel graphical interface having settings that define sound characteristics for the musical instrument to alter the audio signal...

Pennock is merely cited by the Office Action to show an audio signal processing system that graphically displays amplifier functions that provides musical effects using digital processing techniques to inputted musical instrument signals. There is no particular motivation to combine Hasegawa with Pennock, except to, in hindsight, try to approximate Applicant's claimed invention, which is improper. Accordingly, Applicant respectfully submits that Hasegawa is not properly combinable with Pennock, and a prima facie case of obviousness cannot be made.

Also, it should be noted that Pennock (as shown in Figure 1 of Pennock) discloses a separate signal processing device 12 connected between a musical instrument 12 and cabinet-speakers 16, wherein the separate signal processing device 12 implements the DSP musical effects according to the invention of Pennock. Signal processing device 12 may include a display 32 that may display user interfaces shown in Figures 8-12 of Pennock. Applicant respectfully submits that the separate signal processing device 12 of Pennock is not properly implementable within the terminal device 10 of Hasegawa (Figure 2 of Hasegawa) which already includes pre-existing MIDI interface 24 for receipt of keyboard 26 signals, display controlling circuit 21, display 22, and sound source circuit 25. The *intended function* of Pennock as a stand-

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

alone separate signal processing device 12 connected between a musical instrument 12 and cabinet-speakers 16 would be destroyed if it were attempted to be integrated into the system of Hasegawa. Accordingly, Applicant respectfully submits that Pennock and Hasegawa, are not properly combinable, and a prima facie case of obviousness cannot be made.

In any event, even if Pennock and Hasegawa were properly combinable (which Applicant respectfully submits they are not), Applicant respectfully submits that Pennock in combination with Hasegawa, still does not teach or suggest Applicant's amended independent claims 1, 19, and 37 (taken as a whole) having claim limitations related to: in response to a user selecting a musical piece, transmitting *a session file associated with the musical piece*, the session file *including an audio file and multimedia data...* processing the session file utilizing a computing device *to present a multimedia presentation of the audio file to the user...* coupling the musical instrument to the computing device such that *an audio signal from the musical instrument generated responsive to a user playing the musical instrument is transmitted to the computing device...* displaying a control panel graphical interface including an amplifier for a musical instrument, the control panel graphical interface having settings that define sound characteristics for the musical instrument to alter the audio signal ...and...*creating a mixed signal that combines the altered audio signal with the audio file, the mixed signal being transmitted through a sound device such that the user can play the musical instrument in conjunction with the multimedia presentation of the audio file.*

Based on the above, Applicant respectfully submits that the combination of Hasegawa and Pennock does not teach, suggest, or render obvious Applicant's amended independent claims 1, 19, and 37. Applicant respectfully requests that amended independent claims 1, 19, and 37 be allowed and passed to issuance, as well as the dependent claims therefrom.

Appl. No. 09/990,532  
Amdt. Dated 10/20/2005  
Reply to Office action of 8/25/2005

### Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1, 3-14, 16-19, 21-32, 34-37, 39-50 and 52-54 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: 10/20/2005

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### Attachments

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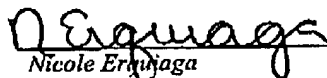
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10/20/2005

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